REMARKS

The applicant acknowledges and appreciates receiving signed copies of the forms PTO 1449 which have been filed in this application.

Claims 1-13, 15, 16, 18-25, 27-33, 35-41, and 43-45 are pending. Claims 14, 17, 26, 34, and 42 are deleted. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claim 44 is objected to. By way of the above amendment, claim 44 is amended to recite a "system" rather than a "method." Withdrawal of the objection is respectfully requested.

Claims 1-45 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent No. 6,556,992, Barney et al. ("Barney"). Independent claims 1, 22, 30 and 38 are amended. Support for the amendments is located in the specification as filed, for example, claim 17; page 51, lines 17-19; page 52, lines 4-6; page 53, lines 3-4, 18-21; page 54, lines 16-20; page 55, lines 5-6; page 57, lines 7-8, 16-22; FIG 16; and FIG. 24-26. Insofar as the rejection may be applied to the claims as amended, the applicant respectfully requests that this rejection be withdrawn for reasons including the following, which are provided by way of example.

The application recognizes that personnel may wish to "label attributes of various intellectual properties and related documents of a company, its partners, and/or competitors, and/or to manage the attributes, to utilize attributes in filtering intellectual property documents." (Page 4, lines 9-12.)

Independent claim 1 is directed to a method for "managing a plurality of attributes in association with a plurality of electronic documents and a plurality of attribute types, implemented by a computer system, where an attribute type can have a plurality of attributes, the attributes and the attribute types are ordered in a tree-structure hierarchy, a document can be

assigned a plurality of attribute types at a same and/or different level in the hierarchy, a document can be assigned a plurality of attributes for one attribute type, the documents are stored in a first data storage, the attributes are stored in a second data storage, and the first data storage and the second data storage are logically separate and different. Claim 1 recites in combination, for example, "(A) providing a group of a plurality of documents including at least one document; (B) selecting a plurality of attributes to be associated with the at least one document; and (C) for each of the selected attributes, automatically tagging, in the first data storage, the documents in the group including the at least one document, with each selected attribute and with all attributes of all ancestors in the hierarchy of each selected attribute; and storing, in the second data storage, respective references in association with each selected attribute and the ancestor attributes, for later retrieval of individual documents in the group, the respective references uniquely indicating respective individual documents in the first data storage, wherein a document is a data record including a plurality of fields, wherein the attribute and the attribute type can be different from the fields in the document and contents of the fields." (See also independent claim 22 (a method for managing a plurality of attributes), claim 30 (a computer program product) and claim 38(a system).)

Thereby, the method and system can provide that "all of the attributes that otherwise would have been selected in a step-by-step manner may be assigned simultaneously and automatically by tagging the intellectual property document or file with not only the selected attribute(s), but all of the other attributes that are at a level higher than the selected attributes." (E.g., specification page 58, lines 1-5.)

On the other hand, without conceding that Barney discloses any feature of the present invention, Barney is directed to a statistical-based rating method and system for assessing the relative breadth, defensibility, and commercial relevance of intellectual property assets. (Co. 5,

lines 56-62.) For example, Barney can generate relative ratings or rankings by comparing a first population of patents to a second population of patents to identify prevalent characteristics, which can be used to predict a desired value or quality or future event in patent or group of patents. (Col. 6, lines 2-23.)

The office action asserts that Barney anticipates the invention as claimed. To the contrary, Barney fails to set forth each and every element found in the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Examples of elements which Barney fails to teach or suggest are discussed below.

Barney fails to teach or suggest, for example, "for each of the selected attributes, automatically tagging, in the first data storage, the documents in the grouping ... with each selected attribute and with all attributes of all ancestors in the hierarchy of each selected attribute." (See, e.g., claims 1, 22, 30, and 38.) Note that "the attributes and the attribute types are ordered in a tree-structure hierarchy," "a document can be assigned a plurality of attribute types at a same and/or different level in the hierarchy," "a document can be assigned a plurality of attributes for one attribute type," and "the document are stored in a first data storage, the attributes are stored in a second data storage, and the first data storage and the second data storage are logically separate and different." To the contrary, Barney cannot automatically tag the documents with an attribute. Barney fails to teach or suggest a hierarchy of attributes and attribute types and hence cannot tag with an attribute as recited. In addition, Barney does not

provide for tagging the documents with attributes of ancestors as recited, in part because Barney does not teach a tree structure of attributes involving ancestors. Furthermore, Barney fails to teach or suggest tagging "the documents in the grouping" with either the attribute or the attribute's ancestors. It appears that the examiner considers the attribute to be a royalty rate, premium or incremental cost, economic life, cost and availability and quality. Even if such can teach an attribute, it fails to teach or suggest the desirability of tagging a group of patents with the same plurality of attributes.

As another example, Barney fails to teach or suggest both "tagging, in the first data storage, the documents in the group ... with all attributes..." and "storing, in the second data storage, respective references with each selected attribute and the ancestor attributes, ... the respective references uniquely indicating respective individual documents in the first data storage." It appears that the examiner considers the reference to be either generally descriptive product patent information or a numerical rating or ranking of a patent. Barney's descriptive information, metrics, or rating or ranking is not stored with each selected attribute and the ancestor attributes. Moreover, Barney's descriptive information, metrics, or rating or ranking cannot be used to retrieve the document because it does not uniquely indicate individual documents in the first data storage.

Insofar as the inheritance of attributes to ancestors, the examiner argues that Barney discloses that "the at least one attribute type inherits the at least one attribute responsive to an association of the at least one second attribute with the at least one document." (Claim 17, now incorporated into claim 1.) The office action considers the following sections of Barney to be particularly relevant: col. 19, lines 35-43; col. 18, lines 60-65; and col. 10, lines 50-62. These sections of Barney, as well as the rest of Barney, have been closely reviewed, and there is no discussion of anything resembling inheritance caused by associating an attribute with a sub-

attribute type. It is particularly unclear in the office action what the examiner considers to be a sub-attribute type, since the cited portions of Barney merely discuss estimating the probability of any given patent being litigated, and the two populations of patents.

With respect to the storage of the documents (originally recited in claim 14), there is a typographical error in the citation to Barney (i.e., "col. 4, lines 58-col. 4, line 13"). The discussion of "Market Approach" and "Income Approach" in the vicinity of the citation has nothing to do with storage of documents in a computer system. The examiner is respectfully requested to clarify. In any event, Barney fails to teach or suggest the first data storage and second data storage which are logically separate and different.

Furthermore, the portion of Barney cited as teaching a document (i.e., col. 10, lines 63-66) fails to teach or suggest that the "document is a data record including a plurality of fields" which is tagged with the attributes and ancestor attributes. To the contrary, Barney discusses for example plugging characteristics of a patent into a regression model, which then outputs a score. (Col. 14, lines 59-60.)

Further with regard to independent claim 30 (and its dependent claims), the office action failed to address where Barney specifically teaches any of the recited "instructions, provided on the at least one computer readable medium." The office action appears to cite observations as teaching the recited instructions. For example, Barney Col. 10, lines 55-62 is cited as teaching instructions on a computer readable medium for providing an attribute type. To the contrary, this portion of Barney discusses "the fundamental observation that not all intellectual property assets are created equal" for reasons including cost consumers are willing to pay, economic life of the technology, cost and availability of substitutes, and quality of underlying patent.

Furthermore, the rejection of claims 30-37 under 35 USC 102(e) is procedurally invalid. The office action simply states that "the limitations of claim 30-37 have mentioned [sic] in the rejection of claims 22-29 above. They are, therefore, rejected under the same rationale." To the contrary, the office action has completely failed to address where Barney teaches the computer program product comprising the "at least one computer readable medium" and the various recited "instructions, provided on the at least one computer readable medium." Because the office action fails to indicate where Barney teaches the computer program product and the various instructions, the rejection of claims 30-37 under 35 USC 102(e) is improper.

Barney fails to teach or suggest, for example, these elements recited in independent claims 1, 22, 30 and 38. It is respectfully submitted therefore that claims 1, 22, 30 and 38 are patentable over Barney.

For at least these reasons, the combination of features recited in independent claims 1, 22, 30 and 38, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, Barney clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 22, 30 and 38, but also because of additional features they recite in combination.

For example, claim 3 recites that "the documents are sorted for visual presentation by: at least one field therein, and at least one attribute, wherein the at least one field is different from the attribute." Barney fails to teach any such visual presentation of documents. Claim 3 is therefore patentable over the references for this additional reason.

Also, claim 7 recites "searching the second data storage for documents based on criteria including at least one of the attributes and a corresponding attribute type, and using the

respective references in the second data storage to locate the documents in the first data storage." (See also claims 24, 32, and 40.) The examiner cites the portion of Barney discussing the "fundamental observation that not all intellectual property assets are created equal" as teaching the searching. To the contrary, Barney fails to teach or suggest a search of any data storage for documents based on criteria, let alone searching the second data storage which stores the attributes, or that the respective references (stored in the second data storage) are used to locate documents in the first data storage. Accordingly, claims 7, 24, 32 and 40 are patentable over the references for this additional reason.

Claim 8, which depends from claim 7, further recites "retrieving the documents in the first data storage based on the respective references." The office action cites a portion of Barney discussion a patent marking database with URL to allow users to "hot-link directly to a third-party web page for each corresponding product and/or associated product manufacturer" as teaching this. This is clearly completely insufficient with regard to the original or amended language of claim 8, for example because the office action has not alleged with respect to claim 1 that the third party web page constitutes the documents which have been stored.

As another example, claim 18 recites "exporting the tree structure hierarchy including the attributes and the attribute types." Barney fails to teach or suggest that the attributes and attribute types can be ordered in a tree structure hierarchy. Accordingly, Barney further fails to teach or suggest exporting such a hierarchy. Claim 18 is therefore patentable over the references for this additional reason.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have

provided specific examples of elements in the claims that are clearly not present in the cited prior art.

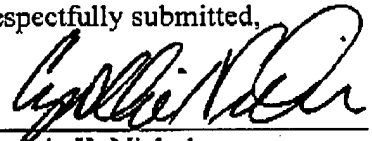
Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

Support for the amendments to the dependent claims is located in the application, for example, page 55, lines 17-20, page 59, lines 1-12, page 54, lines 11-15, and the portions of the application mentioned in connection with the amendments to the independent claims.

In view of the foregoing, the applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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